

REMARKS/ARGUMENTS

Claims 1-32 are now pending in this application. Claims 18-26 have been withdrawn. Claims 1, 6, 12 and 27 are independent claims.

Claim Rejections – 35 USC § 102

Claims 1, 5, 6, 10-17, 27, 28, 31 and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nicholson USPN: 6,724,308 (hereinafter: Nicholson). (Office Action, Page 2). Applicant respectfully traverses these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claims 1, 6, 12 and 27 recite elements that have not been disclosed, taught or suggested by Nicholson. For example, claims 1, 6, 12 and 27 each generally recite:

“said data storage device is a drive tray or a controller”.

The Patent Office cites Nicholson as teaching a container (102). (Office Action, Page 2). The Patent Office asserts that the container (102) of Nicholson is equivalent to the data storage device of the present invention. (Office Action, Page 2). In the present invention, the data storage device is a drive tray or a controller, as cited above. The Patent Office states that the container (102) of Nicholson is a drive tray or a controller. (Office Action, Page 2). However, because a drive tray is referenced nowhere in Nicholson, Nicholson cannot be

construed as disclosing, teaching or suggesting that its container (102) is a drive tray. Further, nowhere in Nicholson is it disclosed, taught, or suggested that its container (102) is a controller.

Nicholson discloses an antenna system (Nicholson: Column 4: Line 53 through Column 5: Line 5; reference numerals 14, 24; FIGS. 1 and 2). The antenna system (24) of Nicholson includes panels (23). (Nicholson: Column 4: Lines 61-67). The container (102) of Nicholson may include an attached tag, so that when the container (102) is passed through the antenna system (24) as indicated in FIG. 2 (see Arrow "A"), the tag on the container may be communicated with by the panels (23) of the antenna system (24). (Nicholson, Column 4: Line 53 through Column 5: Line 5). Nicholson discusses "a controller" at Column 5, Lines 2-5. (See also FIG. 2; Reference Numeral 28). As previously discussed, in the present invention, the data storage device is a drive tray or controller. The Patent Office asserts that the container (102) of Nicholson, which the Patent Office equates with the data storage device of the present invention, is a drive tray or controller. However, Applicant points out that the controller (28) discussed in Nicholson is utilized for controlling the operation of the panels (23) of the antenna system (24), and is a distinct, separate entity from the container (102) which is passed through the antenna system (24). Thus, the container (102) of Nicholson is not a drive tray, nor is it a controller.

Therefore, based on the above rationale, it is contended that Nicholson does not teach the above-referenced elements of Claims 1, 6, 12 and 27. Under *Lindemann*, a *prima facie* case of anticipation has not been established for Claims 1, 6, 12 and 27. Thus, independent claims 1, 6, 12 and 27 should be allowed. Dependent claim 5 (which depends on independent Claim 1), dependent claims 10 and 11 (which depend on independent Claim 6), dependent claims 13-17 (which depend on independent Claim 12) and dependent claims 28, 31 and 32 (which depend on independent Claim 27) should also be allowed.

Claim Rejections – 35 USC § 103

Claims 2-4, 7-9 and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholson in view of Stevens, III, United States Patent Number: 6,747,560 (hereinafter: Stevens). Applicant respectfully traverses these rejections.

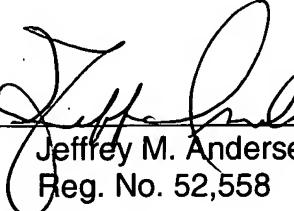
“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.” (emphasis added) *In re Fine*, 837 F. 2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988). Applicant respectfully submits that independent Claims 1, 6, 12 and 27 include elements that do not appear to have been disclosed by any of the references cited by the Patent Office, either alone or in combination.

It is contended that Independent Claims 1, 6, 12 and 27 are non-anticipatory and non-obvious based on the rationale above, therefore Independent Claims 1, 6, 12 and 27 should be allowed. Thus, Dependent Claims 2-4 (which depend on Independent Claim 1), Dependent Claims 7-9 (which depend on Independent Claim 6) and Dependent Claims 29 and 30 (which depend on Independent Claim 27) should also be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

Respectfully submitted on behalf of
LSI Logic,

By: 

Jeffrey M. Andersen
Reg. No. 52,558

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Jeffrey M. Andersen
SUITER • WEST • SWANTZ PC LLO
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile